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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/334,891  | 06/17/1999  | GUIDO GHISOLFI       | 32461/GM/IP         | 5842             |
| 42635   | 7590        | 04/20/2006           | EXAMINER            |                  |
| COBARR SPA<br>P. O. BOX 590<br>6951 RIDGE ROAD<br>SHARON CENTER, OH 44256 |             |                      | PATTERSON, MARC A   |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1772                |                  |

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/334,891 | <b>Applicant(s)</b><br>GHISOLFI, GUIDO |  |
|                              | <b>Examiner</b><br>Marc A. Patterson | <b>Art Unit</b><br>1772                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2006.  
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 36 and 52-61 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
 6) ☒ Claim(s) 36 and 52-61 is/are rejected.  
 7) ☒ Claim(s) \_\_\_\_\_ is/are objected to.  
 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☐ All b) ☐ Some \* c) ☐ None of:  
 1. ☐ Certified copies of the priority documents have been received.  
 2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **REPEATED REJECTIONS**

1. The 35 U.S.C. 103(a) rejection of Claims 36, 52 – 53, 56 – 58 and 61 as being unpatentable over Roulin et al (U.S. Patent No. 5,508,075) in view of Kimura et al (U.S. Patent No. 5,972,445) and Wilson et al (U.S. Patent No. 3,170,832), of record on page 2 of the previous Action, is repeated.
2. The 35 U.S.C. 103(a) rejection of Claims 55 and 60 as being unpatentable over Roulin et al (U.S. Patent No. 5,508,075) in view of Kimura et al (U.S. Patent No. 5,972,445) and Wilson et al (U.S. Patent No. 3,170,832) and further in view of The Encyclopedia of Polymer Science and Engineering (Volume 12, page 214, 1985), of record on page 5 of the previous Action, is repeated.
3. The 35 U.S.C. 103(a) of Claims 54 and 59 as being unpatentable over Roulin et al (U.S. Patent No. 5,508,075) in view of Kimura et al (U.S. Patent No. 5,972,445) and Wilson et al (U.S. Patent No. 3,170,832) and further in view of Curler et al (U.S. Registration No. 28,554), of record on page 7 of the previous Action, is repeated.
4. The 35 U.S.C. 103(a) of Claim 63 as being unpatentable over Roulin et al (U.S. Patent No. 5,508,075) in view of Kimura et al (U.S. Patent No. 5,972,445) and Wilson et al (U.S. Patent No. 3,170,832) and further in view of Waters et al (U.S. Patent No. 5,232,786), of record on page 8 of the previous Action, is repeated.

### ANSWERS TO APPLICANT'S ARGUMENTS

5. Applicant's arguments regarding the 35 U.S.C. 103(a) rejection of Claims 36, 52 – 53, 56 – 58 and 61 as being unpatentable over Roulin et al (U.S. Patent No. 5,508,075) in view of Kimura et al (U.S. Patent No. 5,972,445) and Wilson et al (U.S. Patent No. 3,170,832), 35 U.S.C. 103(a) rejection of Claims 55 and 60 as being unpatentable over Roulin et al (U.S. Patent No. 5,508,075) in view of Kimura et al (U.S. Patent No. 5,972,445) and Wilson et al (U.S. Patent No. 3,170,832) and further in view of The Encyclopedia of Polymer Science and Engineering (Volume 12, page 214, 1985), 35 U.S.C. 103(a) of Claims 54 and 59 as being unpatentable over Roulin et al (U.S. Patent No. 5,508,075) in view of Kimura et al (U.S. Patent No. 5,972,445) and Wilson et al (U.S. Patent No. 3,170,832) and further in view of Curler et al (U.S. Registration No. 28,554), and 35 U.S.C. 103(a) of Claim 63 as being unpatentable over Roulin et al (U.S. Patent No. 5,508,075) in view of Kimura et al (U.S. Patent No. 5,972,445) and Wilson et al (U.S. Patent No. 3,170,832) and further in view of Waters et al (U.S. Patent No. 5,232,786), of record in the previous Action, have been carefully considered but have not been found to be persuasive for the reasons set forth below.

Applicant argues, on page 6 of the remarks dated February 9, 2006, that Wilson et al does not disclose a foamed density suitable for polyesters of the claimed invention, because Wilson et al comprises di, tri or polyethylene glycol, whereas the claimed invention comprises ethylene glycol.

However, Wilson et al also comprises ethylene glycol, if Wilson et al comprises polyethylene glycol; furthermore, as stated on page 4 of the previous Action, Wilson et al teach the use of a polyester having low density, as stated above, and therefore teach the selection of the

density depending on the desired density of the laminated end product. Therefore, one of ordinary skill in the art would have recognized the utility of varying the density of the foamed sheet to obtain the desired density of the laminated end product. Therefore, the density of the laminated end product would be readily determined by through routine optimization of the density of the foamed sheet by one having ordinary skill in the art depending on the desired use of the end product as taught by Wilson et al.

Applicant also argues on page 6 that the 'consisting of' language of Claim 57 precludes the presence of a SiO<sub>x</sub> layer.

However, a polyester sheet which is uncoated is not claimed; furthermore, it is not clear that there is support in the original specification for a sheet which is uncoated.

Applicant also argues, on page 7, that Kimura et al and Wilson et al cannot properly be combined with Roulin et al.

However, it is not clear why Kimura et al and Wilson et al cannot properly be combined with Roulin et al.

Applicant also argues on page 7 that it would not be obvious for one of ordinary skill in the art to provide for a heat sealable film having two layers of different melting points, because of the criticality of each layer with respect to operability.

However, the criticality has not been fully explained, and it is not clear that the criticality is stated in the specification; the claimed invention has therefore not been distinguished from Roulin et al.

Applicant also argues, on page 8, that Roulin et al do not disclose a foamed sheet comprising polyester and that Roulin et al comprises a carrier layer.

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However, Roulin et al discloses polyethylene terephthalate as a polyester of the invention as stated on page 2 of the previous Action, and does not state that the container must comprise a carrier layer.

Applicant also argues on page 8 that the combination of Roulin et al and Kimura et al is improper because Kimura et al is transparent and Roulin et al is not transparent.

However, Kimura is cited only for the teaching that it would be obvious for one of ordinary skill in the art to provide for the claimed crystallinity.

Applicant also argues, on page 9, that Wilson et al teach a polyurethane, rather than a polyester comprising ethylene glycol.

However, as stated on page 4 of the previous Action, a polyester is taught by Wilson et al; furthermore, polyethylene terephthalate is disclosed by Roulin et al.

Applicant also argues on page 9 that Wilson et al do not teach containers.

However, as stated on page 4 of the previous Action, Wilson et al and Roulin et al teach sheets comprising polyester.

Applicant also argues on page 9 that Wilson et al do not teach the claimed density.

However, as stated on page 4 of the previous Action, Wilson et al teach the use of a polyester having low density, as stated above, and therefore teach the selection of the density depending on the desired density of the laminated end product. Therefore, one of ordinary skill in the art would have recognized the utility of varying the density of the foamed sheet to obtain the desired density of the laminated end product. Therefore, the density of the laminated end product would be readily determined by through routine optimization of the density of the

foamed sheet by one having ordinary skill in the art depending on the desired use of the end product as taught by Wilson et al.

Applicant also argues on page 9 that there is no logical basis for combining the teachings of Kimura et al, which comprises sheets, with Roulin et al, which comprises a folded laminate.

However, the laminate disclosed by Roulin et al and the sheet disclosed by Kimura et al are both sheets; therefore, there is motivation to combine the teachings.

Applicant also argues on page 9 that Wilson et al relates to upholstery.

However, as stated above, Wilson et al also is directed to a sheet.

Applicant also argues, on page 10, that the containers of Roulin et al are not entirely recyclable.

However, entirely recyclable containers are not claimed.

Applicant also argues, on page 11, that the claimed containers can be recycled much more easily than those of Waters.

However, ease of recycling is not claimed.

6. The declaration submitted under 37 C.F.R. 1.31 is insufficient to overcome the 35 U.S.C. 103(a) rejection of Claims 36, 52 – 53, 56 – 58 and 61 as being unpatentable over Roulin et al (U.S. Patent No. 5,508,075) in view of Kimura et al (U.S. Patent No. 5,972,445) and Wilson et al (U.S. Patent No. 3,170,832), 35 U.S.C. 103(a) rejection of Claims 55 and 60 as being unpatentable over Roulin et al (U.S. Patent No. 5,508,075) in view of Kimura et al (U.S. Patent No. 5,972,445) and Wilson et al (U.S. Patent No. 3,170,832) and further in view of The Encyclopedia of Polymer Science and Engineering (Volume 12, page 214, 1985), 35 U.S.C.

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103(a) of Claims 54 and 59 as being unpatentable over Roulin et al (U.S. Patent No. 5,508,075) in view of Kimura et al (U.S. Patent No. 5,972,445) and Wilson et al (U.S. Patent No. 3,170,832) and further in view of Curler et al (U.S. Registration No. 28,554), and 35 U.S.C. 103(a) of Claim 63 as being unpatentable over Roulin et al (U.S. Patent No. 5,508,075) in view of Kimura et al (U.S. Patent No. 5,972,445) and Wilson et al (U.S. Patent No. 3,170,832) and further in view of Waters et al (U.S. Patent No. 5,232,786), of record in the previous Action.

The declaration states that Wilson et al is a polyurethane, rather than a polyester, and that the compositions disclosed by Wilson et al are toxic in nature.

However, as stated above, polyesters are disclosed by Wilson et al; furthermore, Wilson et al is only cited for the teaching that a polyester, or other polymer, having low density provides a lightweight product.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc A Patterson whose telephone number is 571-272-1497.

The examiner can normally be reached on Mon - Fri 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Marc Patterson 4/17/06*

Marc A. Patterson, PhD.  
Primary Examiner  
Art Unit 1772